REMARKS

Favorable reconsideration and allowance of the present application are respectfully requested in view of the following remarks. Claims 1-44 remain pending. Claims 1, 13, 23, 34 and 44 are independent.

§ 102 REJECTION – GOODMAN

Claims 1-4, 6-9, 11, 13-16, 18-19, 21, 23-26, 29-30, 32, 34-36, 37, 39, 40, 42, and 44 stand rejected under 35 USC 102(e) as allegedly being anticipated by Goodman et al. (USP 6,636,529). *See Office Action, page 2.* Applicants respectfully traverse.

For a Section 102 rejection to be proper, the cited reference must teach or suggest each and every claimed element. *See M.P.E.P. 2131; M.P.E.P. 706.02.* Thus, if the cited reference fails to teach or suggest one or more elements, then the rejection is improper and must be withdrawn.

In this instance, Goodman fails to teach or suggest each and every claimed element. For example, independent claim 1 recites, in part, "wherein said overhead byte can be utilized to determine whether a receiver should demultiplex said second signal to said first signal."; independent claims 13 and 34 recite in part "demultiplexing said multiplex signal to form a plurality of first signals in a first format if said position overhead byte matches said path label"; and independent claims 23 and 44 recites in part, "multiplexing said first

signals to generated a multiplexed signal" and "placing said multiplexed signal and said provisioned overhead byte in a second format." It will be demonstrated that Goodman cannot be relied upon to teach or suggest at least these features.

Goodman is directed toward interfaces for converting an incoming digital signal into a format for transmission on a synchronous digital network, to network elements comprising such interfaces, to corresponding receiver interfaces. *See column 1, lines 23-27.* Goodman specifically relies on the fact that a number of different packet protocols have a key feature in common. The key feature is that the transmission of the constant bit streams of the incoming digital signals include special codes that indicate gaps between packets, and therefore the start and end points of the packets. *See column 5, lines 25-30.* The device and method as disclosed in Goodman arranges to replace one or more of these idle codes with a header indicating the length of the associated packets. This enables a downstream receiver to identify the end of the associated packet and thus maintains synchronicity with respect to packets and gaps. *See column 3, lines 40-47.* This is shown in Figure 6 of Goodman where in the user data, i.e., the incoming digital signal includes an inter packet gap. The inter packet gap is placed with appropriate headers to indicate starting and ending of user packets.

Goodman goes on to disclose that the device line code recognition and mapping block 330 recognizes the line code of the incoming digital signals and performs an appropriate mapping ready for inserting the signals into the synchronous digital output signal. *See column 9, lines 18-23; Figure 3.* Once the headers are mapped, the resulting output digital signal is then multiplexed into synchronous digital hierarchy framer 300.

It is important to realize that the header generated is in the same format as the incoming digital signal. This along with other headers for other incoming digital signals are multiplexed into a higher rate optical signal and transmitted. Because the mapping information, i.e., the headers, are in the original incoming digital signal format, at the receiver end, the optical signal must be demultiplexed **always** so that the header information may be retrieved.

This is in complete contrast to the inventions as claimed. More specifically, the Examiner asserts that the header as disclosed in Goodman is equivalent to the overhead byte as claimed. However, it is clear that the two are not equivalent. In the present invention as claimed, the overhead byte is not in the format of the first signals. The overhead byte is in the second signal format. This is what allows the receiver to simply view the overhead byte and decide whether or not to demultiplex the second signal into the plurality of the first signal. This is in complete contrast with Goodman where the second signal must always be demultiplexed in order to retrieve the header information.

Thus, it is clear that Goodman cannot be relied upon to teach or suggest the feature of "wherein said overhead byte can be utilized to determine whether a receiver should demultiplex said second signal to said first signal" as recited in claim 1; "demultiplexing said multiplex signal to form a plurality of first signals in a first format if said position overhead byte matches said path label" as recited in independent claims 13 and 34; and cannot be relied upon to teach or suggest the combination of features of "multiplexing said first signals to generated a multiplexed signal" and "placing said multiplexed signal and said provisioned overhead byte in a second format" as recited in independent claims 23 and 44.

For at least the reasons stated above, independent claims 1, 13, 23, 34, and 44 are distinguishable over Goodman. Claims 2-4, 6-9, 11, 14-16, 18-19, 21, 24-26, 29, 30, 32, 35-36, 37, 39, 40, and 42 depend from independent claims 1, 13, 23, or 34 directly or indirectly. Therefore, for at least the reasons stated above with respect to the independent claims, these dependent claims are also distinguishable over Goodman.

Applicants respectfully request that the rejection of claims 1-4, 6-9, 11, 13-16, 18, 19, 21, 23-26, 29, 30, 32, 34-36, 37, 39, 40, 42, and 44 based on Goodman be withdrawn.

§ 103 REJECTION – GOODMAN, WAKIM

Claims 10, 12, 20, 22, 31, 33, 41, and 43 stand rejected under 35 USC 103(a) as allegedly being unpatentable over Goodman in view of Wakim (USP 6,477,178). *See Office Action, page 4.* Applicants respectfully traverse.

For a Section 103 rejection to be proper, a *prima facie* case of obviousness must be established. *See M.P.E.P. 2142.* One requirement to establish *prima facie case* of obviousness is that the prior art references, when combined, must teach or suggest all claim limitations. *See M.P.E.P. 2142; M.P.E.P. 706.02(j).* Thus, if the cited references fail to teach or suggest one or more elements, then the rejection is improper and must be withdrawn.

It is noted that the rejected claims depend from independent claims 1, 13, 23, or 34 directly or indirectly. It has been shown above that Goodman cannot be relied upon to teach or suggest all features of the independent claims. Wakim has not been, and indeed cannot be, relied upon to correct for at least the above-noted deficiencies of Goodman. Therefore, independent claims 1, 13, 23 and 34 are distinguishable from the combination of Goodman and Wakim. Due to the dependency thereon, these dependent claims are also distinguishable over the combination of Goodman and Wakim for at least the reasons stated above with respect to the independent claims.

Applicants respectfully request that the rejection of claims 10, 12, 20, 22, 31, 33, 41 and 43 based on Goodman and Wakim be withdrawn.

CONCLUSION

All objections and rejections raised in the Office Action having been addressed, it is respectfully submitted that the present application is in condition for allowance. Should there be any outstanding matters that need to be resolved, the Examiner is respectfully requested to contact Hyung Sohn (Reg. No. 44,346), to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH &, BIRCH, LLP

By: _____

Michael R. Cammarata
Reg. No. 39,491
HNS

MRC/HNS/jm
4450-230P

P.O. Box 747
Falls Church, VA 22040-0747
(703) 205-8000